

Notice of Allowability

Application No.

10/729,816

Examiner

Golam M M Shameem

Applicant(s)

GORDEEV ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 9/7/04.
2. ☒ The allowed claim(s) is/are 17 and 20-23 (now 1-5).
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Priority

This application is a divisional of 09/996,927 11/29/2001 which claims benefit for domestic priority under 35 U.S.C. §§ 120 and /or 121 is acknowledged.

Status of Claims

Claims 17, and 20-25 are currently pending in the application. Claims 1-16, 18-19 and 26-30 were previously canceled.

Receipt is acknowledged of Applicant's response filed on September 07, 2004 and that has been entered.

Claims 24 and 25 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 12/05/2003, which has been entered in the file.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group II, which includes claims 20 and 21 drawn to compounds and the elected species as set forth in claim 21 with traverse is acknowledged. The traversal is on the ground(s) that the claims of Group III (claims 22 and 23) should be rejoined and examined with the elected Group II because the search and examination of all claims in Group II and III can be made without a "serious burden" on the Examiner.

Applicant's arguments are fully considered and found persuasive (because those claims fall within the scope of elected invention) and therefore, Examiner agrees to withdraw restriction requirements between Groups II and III, and rejoin claims 22 and 23 with the elected invention (Group II). However, during a telephonic interview, with Mr. Sandip Patel (Attorney for Applicant) on October 6, 2004, Applicant has agreed to cancel non-elected claims 24 and 25 of Group IV. On the other hand, Examiner also has agreed to rejoin claim 17. Therefore, the Office action for restriction requirements (mailed on 08/09/2004) for the invention Group IV has been maintained and therefore, the requirement for restriction is still deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Examiner's amendment

An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this Examiner's amendment was given in a telephone interview with Mr. Sandip Patel (Attorney for Applicant) on October 6, 2004.

The application has been amended as follows:

- a. 24 and 25 have been canceled.

Reasons for allowance

The following is an Examiner's statement of reasons for allowance:

Hutchinson *et al* (US 6,124,334) teach the hetero-aromatic ring substituted phenyloxazolidinone compounds, and their methods of uses thereof. The instant compounds differ from the prior art by having a core oxazole ring, which is further substituted directly or indirectly by a chemical moiety such as, B(OH)₂ or a 6-membered heterocyclic ring. The prior art compounds neither teach nor render obvious the instant claimed compounds or their method of preparation and there is no suggestion or motivation to modify the compounds of other prior art to obtain the instant compounds. Therefore the instant claims 17 and 20-23 are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of

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record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read "Golam M M Shameem". The signature is stylized with a large, looping initial "G" and "M".

Golam M M Shameem, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1

October 7, 2004